

**Appl. No.** : **10/821,667**  
**Filed** : **April 9, 2004**

### **REMARKS**

Applicants thank the Examiner for the indication of allowable Claim 33. Claims 1, 4, 5, 8, 12, 19 and 27-32 have been amended, and Claims 15-18 and 23-25 have been cancelled. By way of summary, Claims 1-14, 19-22 and 26-33 are now pending, of which Claims 5-14, 19-22 and 27-32 are withdrawn.

#### Rejections Under 35 U.S.C. §112, first paragraph

The Examiner maintained her rejection of Claims 1-4 and 26 under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. In her response to Applicants' arguments filed on January 12, 2007, the Examiner indicated that the submitted references and Applicants' arguments provide enablement for treating an allergic reaction. However, the Examiner still did not find enablement for preventing an allergic reaction and inhibiting NF-κB mediated cellular proliferation.

Applicants respectfully disagree with the Examiner's rejection and arguments. However, in order to accelerate the prosecution and place the application in a condition for allowance, Applicants have amended Claims 1, 4, 5 and 12 to delete language associated with preventing an allergic reaction, asthma and/or inhibiting NF-κB mediated cellular proliferation. Claims 15-18 and 23-25 were directed toward inhibiting NF-κB mediated cellular proliferation, and have also been cancelled. Claim 19 was amended to depend from Claim 13, and Claims 8, 19 and 27-32 were also amended to make the language more clear. Applicants reserve the right to pursue the deleted and cancelled subject matter in subsequent application(s).

The only remaining subject matters in the pending claims are directed toward treating an allergic reaction and/or asthma, which have been enabled as indicated by the Examiner. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of Claims 1-4 and 26.

#### Rejections Under 35 U.S.C. §103(a)

The Examiner maintained the rejection of Claims 1-3 and 26 under 35 U.S.C. §103(a) as being unpatentable over Masukawa et al. (U.S. Patent 5,017,468) and Ninomiya et al. (EP 353,606). The Examiner treated Claims 1-4 and 26 as compound claims because they only recite

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a pharmaceutical composition without reciting an additional ingredient. The Examiner further argued that “[t]he motivation to make the claimed compounds derives from the expectation that structurally similar compounds would possess similar activity (e.g., a cyan coupler).”

Applicants have amended Claim 1 to add an additional ingredient – “a pharmaceutically acceptable diluent” as suggested by the Examiner, and request that Claims 1-4 and 26 as amended be treated as pharmaceutical composition claims. Applicants maintained that *In re Dillon* is distinguishable and respectfully disagree with Examiner’s arguments. However, even if mere structural similarity of compounds in the prior art can create a presumption of obviousness, the presumption can be rebutted by the showing that claimed compositions possess unexpectedly improved properties or properties that the prior art does not have. *In re Dillon*, 919 F.2d 688, 692-693 (Fed. Cir. 1990).

The prior art only teaches that the imidazole compounds can be used as cyan couplers and are excellent in spectral absorption, absorption coefficient and fastness. The present invention discloses the unexpected new properties of imidazole compounds – ability to reduce or inhibit IgE responses, which is completely different from and unrelated to having good spectral absorption (for being used as cyan couplers). Furthermore, the subject matters of prior art disclosures involve the areas of photographic and non-linear optic materials and are so remote from the pharmaceutical science that the claimed biological/pharmaceutical activity cannot be obvious. A skilled person in the art would never expect or even guess that similar compounds would have presently claimed properties. Therefore, Applicants submit that the present pharmaceutical composition possess new properties not possessed by the prior art materials or suggested in the prior art. Accordingly, Applicants respectfully request that the Examiner withdraw the objections under 35 U.S.C. §103(a).

#### Rejoinder

In the Amendment filed on March 1, 2006, an election was made without traverse to prosecute the invention of Group I, Claims 1-4 and 26. Accordingly, Group II, including Claims 5-14, which are directed to a method for treating or preventing allergic reaction and/or for inhibiting cytokines or leukocytes, Group III, including Claims 15-25, which are directed to a

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method for inhibiting cellular proliferation, and Group IV, including Claims 27-32, which are directed to a process of making, were withdrawn from consideration.

According to M.P.E.P. 821.04, where product and process claims drawn to independent and distinct inventions are presented in the same application, Applicant may be called upon under 35 U.S.C. §121 to elect claims to either the product or process. The claims to the non-elected invention will be withdrawn from further consideration under 37 C.F.R. §1.142. However, if Applicant elects claims directed to the product and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined. Accordingly, Applicants respectfully request that upon allowance of Claim 1, the Examiner permit rejoinder of Claims 5-14 and 19-22 which depend from Claim 1 and Claims 27-32, which have been amended to depend from Claim 1, in accordance with M.P.E.P. 821.04. Thus, all of Claims 5-14, 19-22 and 27-32 now depend from Claim 1 and recited all of the limitations of the allowable product claims.

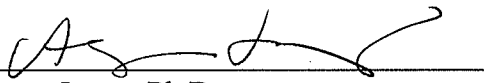
#### CONCLUSIONS

In view of the remarks set forth above, Applicants respectfully submit that Claims 1-14, 19-22 and 26-32 in this application are now in condition for allowance. Should there be any questions concerning this application, the Examiner is respectfully invited to contact the undersigned at telephone number appearing below. Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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Dated: 6/26/07

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